

REMARKS

This Amendment is in response to the outstanding Official Action mailed December 23, 2003, the shortened statutory period for filing a response having expired on March 23, 2004. In this regard, Applicants submit herewith a three-month extension petition to reset the deadline for responding to the Official Action to and including June 23, 2004. In view of the within remarks, reconsideration of the Examiner's rejection is respectfully requested.

The Examiner has rejected claims 43-45, 48, 50-52, 55, 57-59, 62 and 64-66 under 35 U.S.C. § 102 (b) as being anticipated *Matsen III, et al.* United States Patent No. 4,979,949. Of the rejected claims, claims 43, 50, 57 and 64 have been presented in independent form. It is noted that claims 1-42 and 74-81 have been designated as being allowed, the remaining dependent claims being designated as allowable if rewritten in independent form.

Each of the aforementioned independent claims are distinguished over the prior art, *inter alia*, by the limitation of a first assembly for positioning the resection guide along a translational path. On this issue, the Examiner states that *Matsen III, et al.* discloses an alignment guide 54 including a first assembly 152 for positioning the resection guide along a translational path. Contrary to the Examiner's statement, there is no disclosure in *Matsen III, et al.* of an alignment assembly which is operative for positioning a resection guide along a translational path. As previously pointed out to the Examiner in Applicants' communication of September 17, 2003, the assembly 152 in *Matsen III, et al.* is described as a lower arm that is only rotatable about rotational axis 150 as clearly shown in Fig. 8 of the cited reference. As stated in the reference, "The lower arm raises and lowers the wrist by rotation around the

elbow." [Emphasis Supplied] What is made expressly clear from *Matsen III, et al.* is that the assembly referred to by the Examiner as the lower arm 152 rotates, as opposed to any movement along a translational path, See Col. 14, lines 23-25. There is no disclosure in *Matsen III, et al.* of the lower arm 152 being manipulated along a path other than a rotational path. The rotation of the lower arm is an essential feature of the robot 54 as disclosed in *Matsen III, et al.* The manipulation of the components of the robot are all rotational motions as described in Col. 14, lines 19-27. Thus, there is no disclosure in *Matsen III, et al.* of any assembly operative as an alignment guide having a translational path as proclaimed by the Examiner. In fact, the Examiner has not indicated any support in *Matsen III, et al.* for the Examiner's position.

It appears that the Examiner is in agreement with Applicants' position. However, the Examiner erroneously supports the rejection stating that the manner in which the device is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus satisfying the claimed structural limitations, citing *Ex parte Masham*, 2 U.S.P.Q. 2d 1647 (Bd. Pat. App. & Intf. 1987). The authority cited by the Examiner is directed to a different issue and is not relevant to the issue of Applicants' claimed invention.

Specifically, Applicants are not claiming the manner in which a device is intended to be employed. In this regard, in the *Ex parte Marsham* case, the claimed apparatus was intended to be completely submerged in the unclaimed developer material. This intended manner of using the apparatus was held not to be a distinguishing limitation of the claim. In the present claim, Applicants are claiming the specific function of the first assembly, i.e., what it does. It is firmly established that features of an apparatus can be claimed either structurally or

functionally so as to distinguish the apparatus over the prior art. See *In Re Schreiber*, 44 U.S.P.Q. 2d 1429 (Fed. Cir. 1997).

To be an anticipatory reference, the reference itself must expressly or inherently describe each and every limitation set forth in the claim. See *Trintec Inds., Inc. v. Top-U.S.A. Corp.*, 63 U.S.P.Q. 2d 1597 (Fed. Cir. 2002). In an attempt to establish that *Matsen III, et al.* inherently performs Applicants' claimed function of positioning a resection guide along a translational path, the Examiner states that: "The Examiner believes that one could draw an infinite number of straight lines through a point on the resection guide. Each of these lines may be considered a translational path and the resection guide would be positioned along a translational path regardless of its ability to move translationally or along a translational path." This hypothetical statement by the Examiner does not provide any ground for rejection of Applicant's claims over *Matsen III, et al.*.

As such, what the Examiner believes the reference may disclose is not relevant to the anticipation analysis. The Examiner's hypothetical analysis of drawing an infinite number of straight lines through a point has no basis for rejecting Applicants' claims. The Examiner's attempt to construe *Matsen III, et al.* to inherently disclose Applicant's claimed invention is based upon an obvious hindsight review of the cited reference. Furthermore, the Examiner's reference to the aforementioned infinite number of straight lines and their purported relevance to Applicants' first assembly is not clearly articulated. The burden is upon the Examiner to show by clear and convincing evidence that the prior art inherently possesses the functionality identified in Applicants' claimed invention. Here, the Examiner has failed to even remotely provide any evidence of that fact, rather, merely relying upon what the Examiner believes. The Examiner's beliefs are not substitutes

for clear and convincing evidence, i.e., documented facts. Accordingly, the Examiner's rejection is traverse and should therefore withdrawn.

Furthermore, the aforementioned independent claims include the limitation that the alignment guide is "adapted for attachment to the patient's bone." In the Official Action, the Examiner states that the alignment guide 54 of *Matsen III, et al.* is adapted for attachment to the patient's bone. However, as clearly shown in Fig. 3, and as described in Col. 9, lns. 40-44, the robot 54 is "rigidly attached to the operating table 50 by robot safety stand 65. The operating table thus provides a reference structure for the positional relationship between the femur and the robot." Thus, a critical and essential feature of *Matsen III, et al.* is that the robot or alignment guide be rigidly attached to the operating table, and not to the patient's bone as alleged by the Examiner. Thus, the robot or alignment guide in *Matsen III, et al.* is not adapted to be coupled to the patient's bone as claimed by Applicant.

The Examiner states that as to the claimed limitation "adapted for attachment to the patient's bone", it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation, but only requires the ability to solely perform the function, and therefore, does not constitute a limitation in any patentable sense. See *In re Hutchison*, 69 U.S.P.Q. 138 (C.C.P.A. 1946). The Examiner's reliance upon the *In re Hutchison*, case is not appropriate nor germane to the issue presented by Applicants' claims. For example, in *In re Hutchison*, the "adapted for" recitation was found in the preamble of the claim. In the present claims, the "adapted to" recitation is a positive limitation of the claims.

On this issue, the Examiner's attention is directed to *In re Venezia*, 189 U.S.P.Q. 149 (C.C.P.A. 1976). In the *In re Venezia* case, the issue was the claimed limitation "a pair of sleeves of elastomeric material, each sleeve of said pair adapted to be fitted over the insulating jacket of one of said cables." [Emphasis supplied]. In holding that the recitation "adapted to be fitted" was a material limitation of the claim, the Court held:

For example, paragraph two of claim 31 calls for "a pair of sleeves \*\*\* each sleeve of said pair adapted to be fitted over the insulating jacket of one of said cables." Rather than being a mere direction of activities to take place in the future, this language imparts a structural limitation to the sleeve. Each sleeve is so structured or dimensioned that it can be fitted over the insulating jacket of a cable. A similar situation exists with respect to the "adapted to be affixed" and "adapted to be positioned" limitations in the third and fourth paragraphs of the claim. The last paragraph of claim 31 contains additional language criticized by the board, including "may be slideably repositioned," "when said sleeves \*\*\* are assembled," and "when said housing is in its repositioned location." However, this language also defines present structures or attributes of the part of the "kit" identified as the housing, which limits the structure of the housing to those configurations which allow for the completed connector assembly desired. Again, a present structural configuration for the housing is defined in accordance with how the housing interrelates with the other structures in the completed assembly. We see nothing wrong in defining the structures of the components of the completed connector assembly in terms of the interrelationship of the components, or the attributes they just possess, in the completed assembly.

It is noted that the Court specifically held that the "adapted to" recitation was not merely the direction of activities to take place in the future, but the recitation imparted a structural limitation to the sleeve. Accordingly, Applicants' limitation of the alignment guide being "adapted for

attachment to the patient's bone" is a material limitation to be given full consideration in distinguishing over the prior art.

Applicants submit herewith a Supplemental Information Disclosure Statement for consideration by the Examiner. It is noted that the art cited in the enclosed European Search Report are manual alignment apparatuses which, unlike Applicants' claimed invention, are not coupled to a computer navigation system.

As it is believed that all of the rejections set forth in the Official Action have been fully met, favorable reconsideration and allowance are earnestly solicited.

If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that he telephone Applicants' attorney at (908) 654-5000 in order to overcome any additional objections which he might have.

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

Dated: June 17, 2004

Respectfully submitted,

By \_\_\_\_\_

Stephen B. Goldman  
Registration No.: 28,512  
LERNER, DAVID, LITTBENBERG,  
KRUMHOLZ & MENTLIK, LLP  
600 South Avenue West  
Westfield, New Jersey 07090  
(908) 654-5000  
Attorney for Applicants